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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER LE, DEBBIE M	
ART UNIT 2167	PAPER NUMBER

DATE MAILED: 01/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/932,664

Applicant(s)

DEGUCHI, YUICHIRO

Examiner

DEBBIE M LE

Art Unit

2167

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 September 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-45 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-45 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Objections

Claims 1, 15, 28 are objected to because of the following informalities:

The preamble of the claims 1, 15 and 28 claimed "A data marking device data searching system", it appears unclear that the invention claimed 'a data marking device and/or data searching system.

Appropriate explanation and/or correction is required.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 33-44 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The language of the claim raises a question as to whether the claim is directed merely to an abstract idea that is not tied to a technological art, environment or machine which would result in a practical application producing a concrete, useful, and tangible result to form the basis of statutory subject matter under 35 U.S.C 101.

To expedite a complete examination of the instant application the claims rejected under 35 U.S.C 101 (nonstatutory) above are further rejected as set forth below in anticipation of applicant amending these claims to place them within the four categories.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Janik et al (US Patent Application 2003/0005433 A1) in view of Engstrom (US Patent Application No. 2004/0171377 A1).

As per claim 1, Janik discloses a data marking device data searching system comprising:

a data network (fig. 1, # 16);

a user terminal (Fig. 1, #4) coupled to the data network (Fig. 1, # 16) configured to transmit a search request corresponding to a marked data (¶ 0047, as a tag button 6 is activated by a user); and

a server terminal (Fig. 1, # 8) coupled to a data network (Fig. 1, # 16) configured to access one or more storage units (Fig. 1, # 24, page 4, ¶ 0048, lines 1-3) in response to said search request received from said user terminal, and to transmit a result corresponding to said search request to said user terminal (¶ 0045, 0047-0048).

Janik does not explicitly teach wherein said marked data indicates a time and said marked data represents content that is broadcasted at said time and wherein said search request is independent of frequency corresponding to said content that is broadcasted. However, Engstrom teaches 'wherein said marked data indicates a time and said marked data represents content that is broadcasted at said time' as the playlist information could include advance information about the content of a station's schedule, such as a song title, artist, estimated broadcast time and date (see ¶ 0061) 'and wherein said search request is independent of frequency corresponding to said content that is broadcasted' as the user preference may identify a broadcast by station call letters, key word, channel, frequency, or Internet address and may identify an artist, song title, genre (see page 2, ¶ 0023, last 7 lines, ¶ 0025, lines 1-6, page 5, ¶ 0059). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of the cited references to provide a marked data indicates a time and said marked data represents content that is broadcasted at said time and the search request is independent of frequency corresponding to said content that is broadcasted as disclosed by Engstrom's system. This would allow users of Janik's system to find, play, and record broadcasts based on user preferences in order to reduce wastes considerable time finding a suitable broadcast as suggested by Engstrom (see page 1, ¶ 0004, last 6 lines).

As per claim 2, Janik teaches wherein said data network includes one of a Local Area Network (LAN), a Wide Area Network (WAN), and an internet connection (§ 0021).

As per claims 3, Janik teaches wherein said user terminal includes one of a personal computer, an internet access enabled personal digital assistant, Wireless Application Protocol enabled mobile telephone, and an i-mode enabled mobile telephone (§ 0017).

As per claims 4, Janik teaches wherein said user terminal and said serverterminal are coupled to said data network using one of a TCP/IP protocol, and an Appletalk protocol (§ 0021).

As per claims 5, Janik teaches wherein said search request includes an indication of selecting said marked data (§ 0003).

As per claim 6, Janik teaches wherein said indication includes a drag an drop operation of an icon representative of said marked data displayed on said user terminal to an icon representative of said search request (§ 0050).

As per claim 7, Janik teaches wherein said icon representative of said marked data includes a hypertext link (§ 0022).

As per claim 8, Janik teaches wherein said icon representative of said search request includes one of a two-dimensional still image or a three-dimensional still image, and a dynamic video image (§ 0063).

As per claim 9, Janik teaches wherein said user terminal is configured to output a search request in progress display after said search request is transmitted (§ 0050).

As per claims 10-11, Janik teaches wherein said one or more storage units of the server terminal includes one or more user playlist databases, wherein each of said one or more user playlist databases includes information corresponding to the marked data corresponding to the respective users (§ 0048).

As per claims 12, Janik teaches wherein said marked data includes information corresponding to a bookmarked music clip broadcast over a radio station (§ 0003).

As per claims 13-14, Janik teaches wherein said information corresponding to the bookmarked music clip includes one or more of a name of the music clip, a name of the music clip artist, and a name of the music clip album, wherein the result corresponding to the search request transmitted to the user terminal includes one or more of information corresponding to music clips broadcast over one or more radio stations (§ 0050-0051).

As per claim 15, Janik teaches

A data network (Fig. 1, # 16);

A plurality of user terminals (Fig. 1, # 4, end-users, page 2, § 0020, line 6, § 0048, the user also provides the unique serial number for frequency-matching device (4) at the web account. It should be noted that each user has its own unique serial number with the user's account information at the web account. At the result, the system provides a unique serial number to each user matching device is implicitly taught 'a plurality of users') each coupled to the data network (Fig. 1, # 16), one of said

user terminals configured to transmit a search request corresponding to a marked data (¶ 0047, as a tag button 6 is activated by a user).

Janik does not explicitly teach wherein said marked data indicates a time and said marked data represents content that is broadcasted at said time and wherein said search request is independent of frequency corresponding to said content that is broadcasted. However, Engstrom teaches 'wherein said marked data indicates a time and said marked data represents content that is broadcasted at said time' as the playlist information could include advance information about the content of a station's schedule, such as a song title, artist, estimated broadcast time and date (see ¶ 0061) 'and wherein said search request is independent of frequency corresponding to said content that is broadcasted' as the user preference may identify a broadcast by station call letters, key word, channel, frequency, or Internet address and may identify an artist, song title, genre (see page 2, ¶ 0023, last 7 lines, ¶ 0025, lines 1-6, page 5, ¶ 0059). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of the cited references to provide a marked data indicates a time and said marked data represents content that is broadcasted at said time and the search request is independent of frequency corresponding to said content that is broadcasted as disclosed by Engstrom's system. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of the cited references to provide a marked data indicates a time and said marked data represents content that is broadcasted at said time and the search request is independent of frequency

corresponding to said content that is broadcasted as disclosed by Engstrom's system. This would allow users of Janik's system to find, play, and record broadcasts based on user preferences in order to reduce wastes considerable time finding a suitable broadcast as suggested by Engstrom (see page 1, ¶ 0004, last 6 lines).

As per claim 16, Janik teaches wherein each of said plurality of user terminals includes one of a personal computer, an Internet access enabled personal digital assistant, Wireless Application Protocol enabled mobile telephone, and an i-mode enabled mobile telephone (¶ 0017).

As per claim 17, Janik teaches wherein said user terminal and said serverterminal are coupled to said data network using one of a TCP/IP protocol, and an Appletalk protocol (¶ 0021).

As per claim 18, Janik teaches wherein said search request includes an indication of selecting said marked data (¶ 0003).

As per claim 19, Janik teaches wherein said indication includes a drag an drop operation of an icon representative of said marked data displayed on said user terminal to an icon representative of said search request (¶ 0050).

As per claim 20, Janik teaches wherein said icon representative of said marked data includes a hypertext link (¶ 0022).

As per claim 21, Janik teaches wherein said icon representative of said search request includes one of a two-dimensional still image or a three-dimensional still image, and a dynamic video image (¶ 0063).

As per claim 22, Janik teaches wherein said user terminal is configured to output a search request in progress display after said search request is transmitted (§ 0050).

As per claim 23-24, Janik teaches wherein said one or more storage units of the server terminal includes one or more user playlist databases, wherein each of said one or more user playlist databases includes information corresponding to the marked data corresponding to the respective users (§ 0048).

As per claim 25, Janik teaches wherein said marked data includes information corresponding to a bookmarked music clip broadcast over a radio station (§ 0003).

As per claims 26-27, Janik teaches wherein said information corresponding to the bookmarked music clip includes one or more of a name of the music clip, a name of the music clip artist, and a name of the music clip album, wherein the result corresponding to the search request transmitted to the user terminal includes one or more of information corresponding to music clips broadcast over one or more radio stations (§ 0050-0051).

As per claim 28, Janik teaches

A data network (Fig. 1, # 16);

A plurality of user terminals (Fig. 1, # 4, end-users, page 2, § 0020, line 6, § 0048, the user also provides the unique serial number for frequency-matching device (4) at the web account. It should be noted that each user has its own unique serial number with the user's account information at the web account. At the result, the

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system provides a unique serial number to each user matching device is implicitly taught 'a plurality of users') each coupled to the data network (Fig. 1, # 16), one of said user terminals configured to transmit a search request corresponding to a marked data (¶ 0047, as a tag button 6 is activated by a user).

Janik does not explicitly teach wherein said marked data indicates a time and said marked data represents content that is broadcasted at said time and wherein said search request is independent of frequency corresponding to said content that is broadcasted. However, Engstrom teaches 'wherein said marked data indicates a time and said marked data represents content that is broadcasted at said time' as the playlist information could include advance information about the content of a station's schedule, such as a song title, artist, estimated broadcast time and date (see ¶ 0061) 'and wherein said search request is independent of frequency corresponding to said content that is broadcasted' as the user preference may identify a broadcast by station call letters, key word, channel, frequency, or Internet address and may identify an artist, song title, genre (see page 2, ¶ 0023, last 7 lines, ¶ 0025, lines 1-6, page 5, ¶ 0059). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of the cited references to provide a marked data indicates a time and said marked data represents content that is broadcasted at said time and the search request is independent of frequency corresponding to said content that is broadcasted as disclosed by Engstrom's system. This would allow users of Janik's system to find, play, and record broadcasts based on

user preferences in order to reduce wastes considerable time finding a suitable broadcast as suggested by Engstrom (see page 1, ¶ 0004, last 6 lines).

Furthermore, Janik does not explicitly teach wherein said one or more other of said plurality of user terminals configured to permit access to said one user terminal to perform a data searching operation. However, Engstrom teaches 'wherein said one or more other of said plurality of user terminals configured to permit access to said one user terminal to perform a data searching operation' as when a tuner is tuned to a broadcast that is currently playing, another tuner is used to scan for another broadcast based on user preferences [see page 1, ¶0005]. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of the cited references to implement the step of wherein said one or more other of said plurality of user terminals configured to permit access to said one user terminal to perform a data searching operation as disclosed by Engstrom would allow users of Janik's system to Engstrom's system would allow users of Janik's system to find, play, and record broadcasts based on user preferences in order to reduce wastes considerable time finding a suitable broadcast as suggested by Engstrom (see page 1, ¶ 0004, last 6 lines).

As per claim 29, Janik teaches wherein each of said plurality of user terminals includes a storage unit configured to store a user playlist database (¶ 0048).

As per claim 30, Janik teaches wherein said one user terminal is configured to display a search result based on said data searching operation (§ 0050).

As per claim 31, Janik teaches wherein said data searching operation includes accessing a storage unit of said other plurality of user terminals and retrieving data corresponding to said marked data (§ 0048).

As per claim 32, Janik teaches wherein said data corresponding to said marked data retrieval from said storage units of said other user terminals includes information corresponding to broadcast music clips marked by the users of the respective other user terminals (§ 0050-0051).

As per claims 33, Janik teaches
initiating a music search operation utilizing a marked data (§ 0047),
receiving for display a search pending status data (§ 0045);
and receiving a playlist corresponding to said search operation (§ 0048, 0050-0051).

Janik does not explicitly teach wherein said marked data indicates a time and said marked data represents content that is broadcasted at said time and wherein said search request is independent of frequency corresponding to said content that is broadcasted. However, Engstrom teaches 'wherein said marked data indicates a time and said marked data represents content that is broadcasted at said time' as the playlist information could include advance information about the content of a station's schedule, such as a song title, artist, estimated broadcast time and date (§ 0061) 'and wherein

said search request is independent of frequency corresponding to said content that is broadcasted' as the user preference may identify a broadcast by station call letters, key word, channel, frequency, or Internet address and may identify an artist, song title, genre (see page 2, ¶ 0023, last 7 lines, ¶ 0025, lines 1-6, page 5, ¶ 0059). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of the cited references to provide a marked data indicates a time and said marked data represents content that is broadcasted at said time and the search request is independent of frequency corresponding to said content that is broadcasted as disclosed by Engstrom's system. This would allow users of Janik's system to find, play, and record broadcasts based on user preferences in order to reduce wastes considerable time finding a suitable broadcast as suggested by Engstrom (see page 1, ¶ 0004, last 6 lines).

As per claim 34, Janik teaches wherein said initiating step includes selecting a bookmarked music (¶ 0045).

As per claim 35, Janik teaches wherein said icon representative of said search request includes one of a two-dimensional still image or a three-dimensional still image, and a dynamic video image (¶ 0063).

As per claims 36, Janik teaches wherein said playlist includes information corresponding to bookmarked broadcast music including a name information, an artist information and an album information of the bookmarked music (¶ 0050-0051).

As per claims 37-38, Janik teaches storing said received playlist and deleting said received playlist (¶ 0048, ¶ 0056-0059).

As per claim 39, Janik teaches

Detecting a data search operation initiation utilizing a marked data (§ 0047),

Retrieving information corresponding to said search operation (§ 0045, 0047).

Janik does not explicitly teach wherein said marked data indicates a time and said marked data represents content that is broadcasted at said time and wherein said search request is independent of frequency corresponding to said content that is broadcasted. However, Engstrom teaches 'wherein said marked data indicates a time and said marked data represents content that is broadcasted at said time' as the playlist information could include advance information about the content of a station's schedule, such as a song title, artist, estimated broadcast time and date (see § 0061) 'and wherein said search request is independent of frequency corresponding to said content that is broadcasted' as the user preference may identify a broadcast by station call letters, key word, channel, frequency, or Internet address and may identify an artist, song title, genre (see page 2, § 0023, last 7 lines, § 0025, lines 1-6, page 5, § 0059). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of the cited references to provide a marked data indicates a time and said marked data represents content that is broadcasted at said time and the search request is independent of frequency corresponding to said content that is broadcasted as disclosed by Engstrom's system. This would allow users of Janik's system to find, play, and record broadcasts based on user preferences in order to reduce wastes considerable time finding a suitable broadcast as suggested by Engstrom (see page 1, § 0004, last 6 lines).

As per claims 40, Janik teaches wherein said data search operation initiation includes receiving a user selected marked data for said search operation (§ 0003).

As per claims 41-43, Janik teaches wherein said retrieving step includes accessing one or more databases, wherein said one or more databases includes user playlist databases, including updating said one or more databases (§ 0003, 0048).

As per claim 44, Janik teaches wherein said retrieved information includes one or more of song title information, an artist information, and an album information for music broadcasts over one or more radio stations (§ 0050-0051).

As per claim 45, Janik teaches

Means for providing a data network (fig. 1, # 16);

Means for connecting to said data network and transmitting a search request corresponding to a marked data (§ 0047, as a tag button 6 is activated by a user);

Means for connecting to said data network and accessing one or more storage units in response to said search request received from said user terminal, and transmitting a result corresponding to said search request (Fig. 1, # 24, page 4, § 0047-0048).

Janik does not explicitly teach wherein said marked data indicates a time and said marked data represents content that is broadcasted at said time and wherein said search request is independent of frequency corresponding to said content that is broadcasted. However, Engstrom teaches 'wherein said marked data indicates a time and said marked data represents content that is broadcasted at said time' as the playlist information could include advance information about the content of a station's schedule,

such as a song title, artist, estimated broadcast time and date (see ¶ 0061) 'and wherein said search request is independent of frequency corresponding to said content that is broadcasted' as the user preference may identify a broadcast by station call letters, key word, channel, frequency, or Internet address and may identify an artist, song title, genre (see page 2, ¶ 0023, last 7 lines, ¶ 0025, lines 1-6, page 5, ¶ 0059). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of the cited references to provide a marked data indicates a time and said marked data represents content that is broadcasted at said time and the search request is independent of frequency corresponding to said content that is broadcasted as disclosed by Engstrom's system. This would allow users of Janik's system to find, play, and record broadcasts based on user preferences in order to reduce wastes considerable time finding a suitable broadcast as suggested by Engstrom (see page 1, ¶ 0004, last 6 lines).

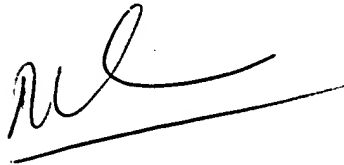
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DEBBIE M LE whose telephone number is (571) 272-4111. The examiner can normally be reached on 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, JOHN BREENE can be reached on (571) 272-4107. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'Debbie Le', with a long horizontal line extending from the end of the signature.

Debbie Le

DEBBIE M LE
Examiner
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Jan. 4, 2005.